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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/848,846	05/19/2004	Theodore W. Neff	10980509-4	6960

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P. O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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FABER, DAVID

ART UNIT	PAPER NUMBER
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2178

MAIL DATE	DELIVERY MODE
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11/13/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/848,846	<b>Applicant(s)</b> NEFF ET AL.	
	<b>Examiner</b> DAVID FABER	<b>Art Unit</b> 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/10/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This office action is in response to the amendment filed on 8 September 2008, and the Information Disclosure Statement filed on 11 October 2008.
2. Claims 24 and 32 have been amended.
3. The rejection of Claims 24-27, 30, and 32-34 under 35 U.S.C. 102(b) as being anticipated by IBM ADF Color Scanner User's Guide (hereinafter IBM) has been withdrawn as necessitated by the amendment. The rejection of Claims 28-29, and 31 under 35 U.S.C. 103(a) as being unpatentable by IBM ADF Color Scanner User's Guide has been withdrawn as necessitated by the amendment. The rejection of nonstatutory obviousness-type double patenting has been withdrawn as necessitated by the amendment.
4. Claims 24-34 are pending. Claims 24 and 32 are independent claims.

### ***Information Disclosure Statement***

5. The information disclosure statement (IDS) submitted on 11 October 2008 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Specification***

6. The specification remains objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The phrase "memory device" is not found to have

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proper antecedent basis in the specification; however it is necessary to use this terminology in order to properly define the claim within the boundaries of statutory subject matter. In order to overcome the object, an amendment to the specification is necessary constituting a non-exhaustive statement of what the phrase "memory device" would be as it would have been known to one of ordinary skill in the art at the time of the invention, in order to verify that the term "memory device" could not be taken in the context of non-statutory subject matter.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 24-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over IBM ADF Color Scanner User's Guide (hereinafter IBM), including screen shots of help files, July 1995 IBM Corporation, pp 1-22, screen shots pp 23-40, which the Applicant provided in the Information Disclosure Statement filed 5/19/2004 in further view of HP PrecisionScan Pro User's Guide, (hereinafter HP), 1998, pp 1-110.

Examiner provides the printout "Hewlett-Packard Launches Scanners With USB", published 8/4/1998, as evidence that HP PrecisionScan Pro was known, available, and shipped to the public at least as of August 17 1998.

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As per independent claim 24, IBM discloses a method comprising:

- displaying, by scanner software, preview scan data generated in response to a preview scan of the document; (pp.36-37: Discloses a prescan image of the document is displayed to the user in a “prescan window”)
- selecting a region of interest in the preview scan data; (p 36 – Discloses square box inside the prescan window that outlines the part of the prescanned image you wish to scan)
- presenting, from scanner software to an application software, one or more data formats for the selected region of interest; (p 37 – disclose the option of the file format being bitmap. In addition, p35, p39 and p40 discloses the user has the ability to select and choose which file format to save the scan to using the file save settings option, wherein after the user selects the file format, the user clicks ok button to input the selection wherein the selection is received when the ok button is clicked. (p40))
- storing data relating to the second scan of the document in the selected one data format. (it is implicit that within the scanner software operating in a computer environment will store the final scanned image within a memory of a computer specified by the user using the file save settings (p40))

However, IBM fails to specifically disclose using an input device to select the region of interest in the preview scan data, drag the selected region of interest across the video display, and drop the selected region of interest into the application software; determining a boundary and image data elements of the selected region of interest by

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evaluating and classifying a click point and performing segmentation analysis on the image data elements contained within the boundary; automatically initiating the scanner software to launch an optimized final scan of the selected region of interest after the selected region of interest is dragged and dropped into the open software application. On the other hand, HP discloses the ability image in the selection area can be dragged and dropped into another program that supports drag-and-drop after selecting a region of interest wherein the user can position the pointer inside the selection area, click on the area, and be able to drag and drop the selected area into the destination program from the scanner software. In response, the final scan of the image is performed and appears in destination program. (Page 91, 97) Furthermore, when the area of the image is selected that becomes a region of interest, the area is enclosed by a selection border wherein the image insider the selection border is vivid, while outside of the border appears faded. In addition, handles appears on the corners and in the middle of each side of the selection border. Thus, boundary and image data elements are determined by the evaluation of and classification a click point, and segmentation analysis was performed. (pg 50-61)

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified IBM's scanning software with HP's ability to drag and drop feature since it would have provided the benefit of letting the user quickly create excellent electronic image from pictures and convert text on paper into editable text.

As per dependent claim 25, IBM discloses:

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- the scanner software determining a data type of the selected region of interest; and (p37 Item Scan Mode – discloses the 255 gray scale (gray) image data type
- the scanner software presenting the one or more data formats associated with the determined data type. (p37 – discloses file format bitmap (.bmp) It is implicitly known in the art that known image formats of .bmp supports 255 shaded gray scale image data)

As per dependent claim 26, IBM discloses receiving user input indicating selection of the application software; and in response to the user input indicating selection of the application software, the application software receiving the presented one or more data formats. (p35 – The user has the ability to specify to export the scan image to a application, wherein the user needs to choose the file format and scan mode that the application. Thus, the user has the ability to select and input the file format to the computer to save the final scan using file save format. (p37, p40))

As per dependent claim 27, IBM discloses the application software determining whether any one of the presented one or more data formats is acceptable to the application software; and in response to the application software determining that any one of the presented one or more data formats is acceptable, the application software notifying the scanner software that the application software is able to receive scan data. (p35 – Discloses that certain applications implicitly know which file formats and scan

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modes to accept. For example, Windows Paintbrush only accepts bmp and certain scan modes stored as pcx file formats, not tiff format.)

As per claim 28, IBM fails to specifically disclose in response to the application software determining that none of the one or more data formats is acceptable, the application soft-ware causing presentation of an indicator that receipt of scan data is not allowed. However, it was well known to one of ordinary skill in the art at the time of Applicant's invention of an error message popping up (i.e. alert box) on the screen indicating an error has occur when file formats are not compatible with an application. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified IBM's scanning software with error messages since it provides an efficient and immediate response notifying a unexpected condition has occurred when the condition occur for the user to consider.

As per dependent claim 29, IBM discloses receiving a input at a location on the displayed preview scan data; and evaluating preview scan data around the location of the input to identify the region of interest. (Pg 36 – Discloses the user has the ability to adjust and move a outlined squared box inside the window to indicate and designate the part of the prescanned image that the user wishes to scan. Pg 37- shows the visual example of the box in the window of the prescanned image.) However, IBM fails to specifically disclose a click input. However, IBM discloses user selection of application settings before a final scan commences using a mouse (pg 18-19) wherein the use of a moue for selecting is well known in the software art.



It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified IBM's scanning software with the use of a mouse since it provides the user with a quick, simple and efficient way of finding, pointing and selecting an item on the screen.

As per dependent claim 30, IBM discloses:

displaying a window for the application software; (p37 – Discloses application software window)

receiving user input indicating that the selected region of interest is to be moved to the window for the application software, (pg 36-37: Discloses the user adjust and move the squared, outline box inside the prescan window that outlines the part of the prescanned image you wish to scan)

wherein receiving the selection of the one or more data formats and launching the second scan are performed in response to the user input. (The user has the ability to select and input the file format to the computer to save the final scan using file save format. (p37, p40) Once selected, the user clicks the OK button which will scan the document)

As per dependent claim 31, Claim 31 recites similar limitations as in Claim 30, and is similarly rejected under rationale. Furthermore, IBM discloses

- displaying a desktop on a computer; (According to page 13, line 24, the Applicant defines the desktop as an open application. Therefore p18 Defining a Scan and Save Action, Windows Paintbrush),

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- receiving user input indicating that the selected region of interest is to be moved to the desktop, (p35, p37-p38 –IBM teaches of exporting the selected image within the outlined box from the prescanned window, from the software scanner, to another application.

However, IBM fails to specifically disclose displaying an icon representing the data relating to the second scan in the desktop. However, the limitation of displaying an icon representing the data relating to the second scan in the desktop is well-known in the software art as being implemented by Windows Explorer within Windows 95 operating system wherein the functionality of displayed icons provides the benefit of a simple, quick, and ease of use aid in assisting the organization of files in a visual manner through a graphical user interface.

As per independent claim 32, Claim 32 recites similar limitations as in Claim 24, and is similarly rejected under rationale. Furthermore, IBM discloses a monitor, (p24. In addition, it is inherent that in order for a user to view the displayed windows and graphical user interface, a monitor must be presented), input device (pg 3), and memory device (pg 40: Discloses saving file on hard drive)

As per dependent claim 33, Claim 33 recites similar limitations as in Claim 25, and is similarly rejected under rationale.

As per dependent claim 34, Claim 34 recites similar limitations as in Claim 27, and is similarly rejected under rationale.

***Response to Arguments***

9. Applicant's arguments with respect to claims 24-32 have been considered but are moot in view of the new ground(s) of rejection.

Arguments addressing in regards of the new limitations of Claims 24, and 32 brought forth in the amendment using an input device to select the region of interest in the preview scan data, drag the selected region of interest across the video display, and drop the selected region of interest into the application software; determining a boundary and image data elements of the selected region of interest by evaluating and classifying a click point and performing segmentation analysis on the image data elements contained within the boundary; automatically initiating the scanner software to launch an optimized final scan of the selected region of interest after the selected region of interest is dragged and dropped into the open software application has been viewed the new ground of rejection of 35 USC 103(a) under new references using HP PrecisionScan Pro User's Guide.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- OmniPage Pro for Windows 95: Discloses scanning documents into applications

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Faber whose telephone number is 571-272-2751. The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Faber/  
Examiner, Art Unit 2178

	/CESAR B PAULA/ Primary Examiner, Art Unit 2178
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